

REMARKS

Claims 1-37 are in this case. All claims have been rejected. Applicants traverse all rejections.

Nonstatutory Double Patenting Rejection:

Claims 1, 4-6, 8-10, 14-19, 22-24 and 28-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 7, 9, 14, 15, 20, 31, 33, 37, 39 and 41 of U.S. application serial number 09/769,192.

Applicants wish to thank the Examiner for pointing out that a timely filed terminal disclaimer in compliance with 37 CFR §1.321 (c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

Applicants herewith attach a terminal disclaimer under 37 C.F.R. §1.321 with regard to commonly owned U.S. application serial number 09/769,192.

CLAIM REJECTIONS - 35 U.S.C. §102(e):

Claims 1-4, 6-10, 15-27, 29, 30 and 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,356,689, "Article Comprising an Optical Cavity", issued March 12, 2002 to Greywall (hereinafter "Greywall").

It is well established that a prior art patent anticipates a claimed invention only if the patent discloses each and every limitation of the claim.

There are two independent claims in this application, claims 1 and 24. Claim 1 calls for a micro-electro-mechanical (MEMS) device comprising at least one resilient member coupled to the component layer and the actuator layer, wherein the component layer, spacer and actuator layer are held in laterally-aligned and vertically spaced relation by resilient force from the resilient member. Claim 24 calls for a method of assembling a MEMS device at ambient temperature comprising inter alia, the step of coupling at least one resilient member to the component layer and the actuator layer to hold the component layer, the spacer and the actuator layer together by resilient force.

Greywall does not disclose a resilient member coupled to the component layer and the actuator layer, or a resilient member to the component layer and the actuator layer to hold the component layer, the spacer and the actuator layer together by resilient force. Therefore Greywall does not anticipate the invention under 35 U.S.C. §102(e). The examiner cites to the use of the term "joining" in Greywall as somehow disclosing the separate resilient member component. It does not. The inventive resilient member specifically alleviates the need for bonding, welding, and other similar joining processes. (Specification, page 9, line 4).

CLAIM REJECTIONS - 35 U.S.C. §103(c) / 102(e):

Claims 5, 11-14, 28, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greywall as cited above.

The instant application was filed one January 25, 2001. Greywall was earlier filed on March 25, 2000, and then issued March 12, 2002 during the prosecution of this application. Therefore the 103(a) rejection falls under 35 U.S.C. §103(c) as Greywall is only prior art under 35 U.S.C. §102(e). Because this application was filed after November 29, 1999, it falls within the new rule of

common ownership as excluding commonly owned patents at the time of applicant's invention.

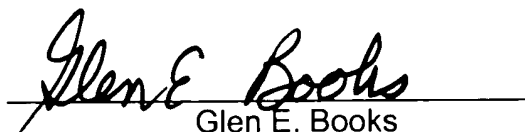
Therefore all obviousness rejections over U.S. Patent No. 6,356,689, issued to Greywall, are respectfully traversed. Greywall is not prior art under 35 U.S. C. 103 (a) since Greywall was commonly owned at the time of this invention. As per the modified policy on evidence to establish common ownership (1241 OG 96, Dec. 26, 2000), the following statement concerns common ownership at the time of invention of the instant application.

STATEMENT OF COMMON OWNERSHIP

Application Serial No. 09/769,193 and Patent No. 6,356,689 were, at the time the invention of Application Serial No. 09/769,193 was made, owned by Lucent Technologies Inc., Murray Hill, New Jersey.

Accordingly it is submitted that this case is now in condition for allowance. Reconsideration and favorable action in this regard are earnestly solicited.

Respectfully submitted,



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Date: January 6, 2003

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T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 25-Jan-03APPL. S.N.: 09/769,193TO: EXAMINER Doan, JenniferART UNIT: 2874FROM: Hoppe, Sharon

PARALEGAL SPECIALIST

RETURN THIS MEMO TO: CP4-6D34SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 13-Jan-03

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. **THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE.** When your action is complete, please initial, date and return this memo to me. **THANK YOU.**

☒ The T.D. is PROPER and has been recorded (see ¶ 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):

- ☐ The TD fee of _____ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).
- ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application patent (see ¶ 14.26 & 14.26.01).
- ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see ¶ 14.27.01).
- ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see ¶ 14.26 & 14.26.02).
- ☐ The person who signed the T.D.:
- ☐ is not an attorney "of record" (see ¶ 14.29 and 14.29.01).
 - ☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).
 - ☐ is not recognized as an officer of the assignee (see ¶ 14.29 & possible 14.29.02).
- ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).
- ☐ The T.D. is not signed (see ¶ 14.26 & 14.26.03).
- ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).
- ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶ 14.26, 14.27.02 or 14.26.05).
- ☐ The period disclaimed is incorrect or not specified (see ¶ 14.26, 14.27.02 or 14.26.03).
- ☐ Other:

☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials:

Date:

Log Date: